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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/567,788	02/16/2007	Reiner Fischer	2400.0210000/SRL	2694
26111	7590	12/01/2009	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			CHU, YONG LIANG	
			ART UNIT	PAPER NUMBER
			1626	
			MAIL DATE	DELIVERY MODE
			12/01/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/567,788	FISCHER ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	YONG CHU	1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 09/18/2009.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 6-13 and 15-24 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-5 and 14 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                         | Paper No(s)/Mail Date. _____ .                                    |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ . | 5) <input type="checkbox"/> Notice of Informal Patent Application |
|  | 6) <input type="checkbox"/> Other: _____ .                        |

## **DETAILED ACTION**

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 09/18/2009 has been entered. Upon entering the submission, claims 1-24 are currently pending in the instant application. Claims 6-13 and 15-24 remain withdrawn as non-elected subject matter. Therefore, claims 1-5 and 14 are under examination on the merits.

### ***Response to RCE Submission***

#### **Claim objection**

Applicants' amendment has obviated the objection of claim 1. However, claim objection for containing non-elected subject matter is maintained, because the instantly examined claims 1-5 and 14 still contain non-elected subject matter.

#### **Claim rejection under 35 U.S.C. §103(a)**

Applicants' arguments have been fully considered, but are not persuasive. Applicants' first argument is Maetzke does not disclose the presently claimed compound, which the Examiner agrees. However, this a 103(a) rejection, not a 102(a)/(b)/(e) type rejection. It is not required that the prior art teaches the same invention as the instant invention does. The key issue is whether the difference is

obvious to one skilled in the art. This turns to the second argument by Applicants. Applicants argued that Maetzke teaches compounds as herbicides, and the presently claimed compounds demonstrate insecticidal activity. However, the Abstract of the instant application clearly states that the compounds are used as pesticides and/or herbicides. It is clear that both applications share the same utility. In addition, such difference is "an objective reach of a claim", and some difference in activity is indeed expected. Since a product is inseparable from its properties, it is an objective reach of a claim from prior art teachings, even though the compounds are used for different purposes. The Maetzke reference is reasonably pertinent to the particular problem with the inventor was involved. The fact that applicants have recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. According to KSR decision, first, KSR tells us that what matters is the "objective reach of the claim." 127 S. Ct. at 1742, 82 USPQ2d at 1397; second, KSR also tells us that in evaluating obviousness we are not to be confined "to the problem the patentee was trying to solve." 127 S. Ct. at 1742, 82 USPQ2d at 1397. The Federal Circuit has expressed similar reasoning in a case involving teachings from a *combination* of two or more references to meet the objective reach of a claim. *In re Kemps*, 97 F.3d 1427, 1430, 40 USPQ2d 1309, 1310 (Fed. Cir. 1996) ("Although the motivation to combine here differs from that of the applicant, the motivation in the prior art to combine the references does not have to be identical to that of the applicant to establish obviousness." See also *In re Beattie*, 974 F.2d 1309, 1312, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992) (the law does

not require that the teachings of references be combined for the reasons contemplated by the inventor)”. In response to applicant's argument that the presently claimed compounds exhibit 33% to 100% more insecticidal activity than the Maetzke compounds have, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. In addition, Applicants do not demonstrate all the compounds with *meta*-substituted phenyl compounds have unexpected and superior activity than *para*-substituted phenyl compounds. Finally, an additional Declaration is required to cure the defect of the previous Declaration if Applicants intend to use Declaration for demonstrating unexpected results.

Therefore, the rejection is maintained.

### ***Conclusion***

No claim is allowed.

### ***Telephone Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yong Chu, Ph.D., whose telephone number is 571-272-5759. The examiner can normally be reached between 7:00 am - 3:30 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. M<sup>c</sup>Kane can be reached on 571-272-0699. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Status Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Yong Chu/  
Primary Patent Examiner  
Art Unit 1626